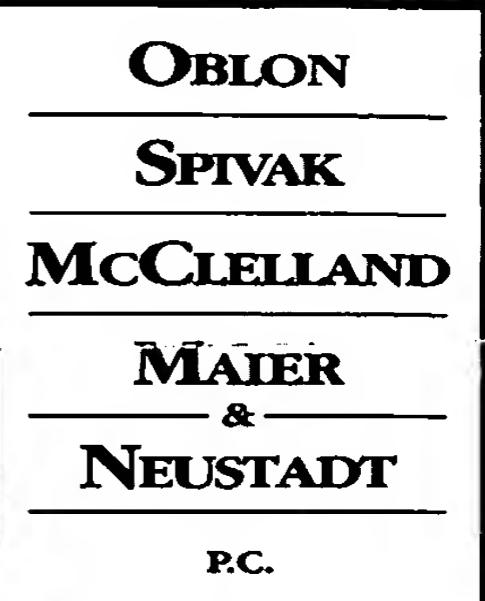


Docket No.: 241858US2



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/647,336

Applicants: Takaya SUDA

Filing Date: August 26, 2003

For: MEMORY CARD AUTHENTICATION SYSTEM,
MEMORY CARD HOST DEVICE, MEMORY CARD,
STORAGE AREA SWITCHING METHOD, AND
STORAGE AREA SWITCHING PROGRAM

Group Art Unit: 2185

Examiner: LANE, JOHN A.

SIR:

Attached hereto for filing are the following papers:

**PETITION UNDER 37 C.F.R. § 1.181
RESPONSE AND REQUEST FOR RECONSIDERATION**

Our credit card payment form in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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DOCKET NO: 241858US2



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TAKAYA SUDA : EXAMINER: LANE, JOHN
SERIAL NO: 10/647,336 :
FILED: AUGUST 26, 2003 : GROUP ART UNIT: 2185
FOR: MEMORY CARD :
AUTHENTICATION SYSTEM, MEMORY
CARD HOST DEVICE, MEMORY CARD,
STORAGE AREA SWITCHING METHOD,
AND STORAGE AREA SWITCHING
PROGRAM

PETITION UNDER 37 C.F.R. § 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Petition is in response to the Official Communication mailed on April 11, 2006.

This Petition under 37 C.F.R. § 1.181 requests that the requirement under 37 C.F.R. §1.105 be withdrawn as unsupported by the rules and unreasonably burdensome.

In the outstanding Official Communication, the following items were required: (1) any documentation known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the invention as defined by the independent claims and a discussion of relevant passages with respect to the claims; (2) identification of all independent claim limitations (claims 1, 2, 8, 9, 13, 16 and 22) corresponding to prior art elements in the background documentation; (3) identification of all present independent claim limitations corresponding to prior art elements in the IDS documentation filed October 25, 2005 and August 26, 2003; (4) All claim language that does not have antecedent basis in the descriptive portion of the

specification; (5) for claim language added to any present claim on amendment and any new claim, identify support for each claim limitation (including structural and functional language linking claim elements, e.g. coupled to, responsive to) by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s) and the corresponding limitation; (6) in the event the foreign priority application is needed to support any claim limitation, applicant must identify such limitations and corresponding translated English language text in the priority application and in the event documentation is incorporated by reference and is relied upon for supporting claim limitations, identification of such supporting text and limitations.

Turning now to the rule governing requests for information. 37 C.F.R. §1.105 states, in part,

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under §1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example...

(viii) Technical information known to applicant. Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability, or concerning the accuracy of the examiner's stated interpretation of such items...

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

- (i) A requirement for factual information;
- (ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or
- (iii) Stipulations as to facts with which the applicant may agree or disagree.

Further M.P.E.P. §704.11 states that,

[i]nformation which may be required under 37 CFR 1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111...[t]here must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant

that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

As can be seen in the sections cited above, the purpose of 37 C.F.R. §1.105 is to allow the Examiner to request factual information which would be reasonably necessary to properly examine or treat a matter; factual information being reasonably necessary, for example, when the Examiner needs assistance finding prior art or resolving an issue arising from the results of a search or analysis of the application file.

For instance, all of the examples listed in 37 C.F.R. §1.105 and M.P.E.P. §704.11(a) are directed to requests for factual information regarding the filed application.

Turning now to the specific items requested in the outstanding Office Action.

With regard to item (1) Applicants respectfully submit that no documentation is known that qualifies as prior art under §102 and §103.

With regard to item (2) the outstanding Communication requested identification of all independent claim limitations (claims 1, 2, 8, 9, 13, 16 and 22) corresponding to prior art elements in the background documentation. This item requires the Applicant to do more than relay facts as is required by §1.105. Instead, this requirement forces the Applicant to make a legal conclusion which is the domain of the Examiner.

With regard to item (3) the outstanding Communication requested identification of all present independent claim limitations corresponding to prior art elements in the IDS documentation filed October 25, 2005 and August 26, 2003. As with item (2) discussed above, this item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Further, the requirement of item (3) is in conflict with the provisions of 37 C.F.R. §§ 1.97 and 1.98 which govern information disclosure statements (IDS). If Applicants were obliged to identify all present independent claim limitations corresponding

to prior art elements in every filed IDS using §1.105, it would be, in effect, adding a further requirement to §1.97 which is not currently part of the rule. Therefore the item (3) requirement is clearly in conflict with §§1.97 and 1.98.

With regard to item (4) the outstanding Communication requested all claim language that does not have antecedent basis in the descriptive portion of the specification. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to conclude that specific claim language does or does not have antecedent basis. This requirement is within the domain of the Examiner and is contrary to the provisions of §1.105.

With regard to item (5) the outstanding Communication requested that for claim language added to any present claims on amendment and any new claims, identify support for each claim limitation (including structural and functional language linking claim elements, e.g. coupled to, responsive to) by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s) and the corresponding limitation. However, as no amendments have been made in the present case, no support for amendments can be provided as is required by item (5).

With regard to item (6) the outstanding Communication requested that in the event the foreign priority application is needed to support any claim limitation, applicant must identify such limitations and corresponding translated English language text in the priority application. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to conclude that specific claim language is supported only by the foreign priority application. This requirement is within the domain of the Examiner and is contrary to the provisions of §1.105.

Application No. 10/647,336
Reply to Official Communication of April 11, 2006

With regard to item (7) the outstanding Communication requested that in the event documentation is incorporated by reference and is relied upon for supporting claim limitations, identification of such supporting text and limitations. This item requires the Applicant to make a legal conclusion which goes beyond the requirements of §1.105. Instead of merely requiring the Applicant to relay facts, this item requires the Applicant to conclude that specific claim language is supported only by documentation incorporated by reference. This requirement is within the domain of the Examiner and is contrary to the provisions of §1.105.

In the outstanding Office Action of April 11, 2006, in the section entitled Office Action Summary, Claims 1-22 are listed as rejected. In the section entitled Detailed Action no rejection of Claims 1-22 is made. Thus, in effect the Examiner appears to be rejecting the claims using §1.105.

Therefore it is submitted that the scope of the outstanding Request for Information under §1.105 is not narrowly defined and the Examiner did not have a reasonable basis for requiring information in this case.

Accordingly, it is respectfully submitted that this Petition under 37 C.F.R. §1.181 be granted and that the Examiner withdraw his requirement for information under §1.105.

Respectfully submitted,

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